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OFFICE OF PETITIONS

In re Application of	:
Dryja et al.	:
Application No. 09/387,158	: Petition for
Filing Date: August 31, 1999	: Patent Term Extension
Docket No. 0300-005009	:
For: Retinoblastoma Nucleic Acids	:

The above-identified application has been forwarded to the undersigned for consideration on a petition entitled "Petition for Adjustment of Patent Term Extension under 37 CFR 1.54(b) for an Application Filed Between June 8, 1995 and May 28, 2000," received on August 28, 2007.

The petition under 37 CFR 1.701 granted-in-part.

Petitioner notes that the above-identified application was filed on August 31, 1999, and allowed on August 10, 2007, but issuance was delayed due to suspensions in prosecution for a potential interference. Petitioner states that the USPTO failed to provide patent term extension for the second suspension (Letter of Suspension mailed November 18, 2002), third suspension (Letter of Suspension mailed August 12, 2003) and the "Order-Termination of Proceedings-Bd.R.8" issued by the Board of Patent Appeals and Interferences on October 12, 2006.

Petitioner asserts that the application was suspended for three periods from February 25, 2002 and ending on September 21, 2004, but only received patent term extension for the first period beginning on February 25, 2002 and ending November 17, 2002. Petitioner argues that the period of extension under 37 CFR 1.701(c)(1)(ii) should be for the entire period from February 25, 2002 to September 21, 2004 for an extension of 938 days.

Petitioner asserts that the period of extension under 37 CFR 1.701(c)(1)(i) should be for the entire period from September 22, 2004, the date of the declaration of the interference to October 12, 2006, the termination of proceedings for an extension of 750 days.

Petitioner request that the patent term extension information be changed in the PALM records and the patent be changed to reflect an extension of 1688 days.

On February 25, 2002, a first Letter of Suspension was mailed by the Office.

On November 18, 2002, a second Letter of Suspension was mailed by the Office.

On August 12, 2003, a third Letter of Suspension was mailed by the Office.

On September 22, 2004, a Declaration of Interference was mailed by the Office.

On December 7, 2005, a judgment was made, by a decision mailed by the Board of Patent Appeals and Interferences.

On October 12, 2006, a notice titled "Order-Termination of Proceedings-Bd.R.8" was faxed to Petitioner by a paralegal at the Board of Patent Appeals and Interferences.

The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154. 35 U.S.C. § 154 provides for patent term extension for appellate review, interference and secrecy order delays in utility and plant applications filed on or after June 8, 1995, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for other specifically defined administrative delays in utility and plant applications filed on or after May 29, 2000.

The above-identified application was filed on August 31, 1999. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute.

Petitioner asserts that under 37 CFR 1.701(c)(1)(ii); the patent term extension should be 938 days for the delay due to the suspension in prosecution due to the interference. While prosecution in the application was suspended three times, the suspensions were due to a potential interference with applicants' application with other application(s), not to await the result of interference in another application. As a result, the provision of 37 CFR 1.701(c)(1)(ii) does not apply. The provisions of 37 CFR 1.701(c)(1)(ii) apply to suspensions by the Office due to interference proceedings under 35 U.S.C. 135(a), however, in this instance there was no interference proceeding. Therefore, petitioners' argument that he is entitled to patent term extension for the period of suspension under 37 CFR 1.701(c)(1)(ii) is not persuasive. The application is not entitled to the extension which was calculated based on the February 25, 2002 Letter of Suspension because the suspension was not to await the outcome of an interference, but due to a potential interference. The application is entitled to zero (0) days of patent term extension under 37 CFR 1.701(c)(1)(ii).

According to 37 CFR 1.701(c)(1)(i), the application is entitled to patent term extension for the number of days, in the period beginning on the date the interference was declared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application. The interference was declared on September 22, 2004, the date of the Declaration of

Interference. A final decision was entered in favor of the senior party on December 7, 2005, the date of the decision of decision by the Board of Patent Appeals and Interferences. According to 37 CFR 1.661, after a final decision by the Board is entered, interference is considered terminated when no appeal or other review has been or can be taken. As a result, the period of extension is 504 days, the period from September 22, 2004, the date of the declaration of interference to February 7, 2006, which is two months after the mailing of the decision by the Board including the beginning and end dates.

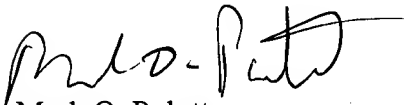
While Petitioner argues that additional patent term extension should be granted because the interference was not terminated until October 12, 2006, the date of receipt of the "Order-Termination of Proceeding-Bd. R. 8", the interference was terminated two months after the mail date of the decision by the Board; when no further appeal was taken. The paper that Petitioner argues should be considered the termination date is not a decision signed by a panel from the Board. After the Board entered the final decision, there were no further interference proceedings with respect to the application, thus the application is not entitled to additional patent term extension.

The delay in issuance of petitioner's patent is regretted. However, the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

The Office proposes to issue a certificate of correction in order to rectify the error regarding the patent term extension information. See 35 U.S.C. 254 and 37 CFR 1.322. Applicant is given THIRTY (30) DAYS to respond to this letter. If no objection is received from applicant, the Office will issue a certificate of correction indicating that the patent term is extended for **502 days** under 35 U.S.C. 154(b). This time limit is NOT extendible under 37 CFR 1.136

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41(a)(7). Accordingly, as authorized the \$200 fee has been charged to Petitioners Deposit Account (50-1895).

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



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